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Reply Brief
(1)
Docket No. 5383

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

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Appellant : Russell F. MIZELL, III
Serial No. : 08/654,600
Filed : May 29, 1996
For : INSECT ATTRACTION AND CAPTURE DEVICE
Art Unit : 3643
Examiner : Kurt Rowan

REPLY BRIEF

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Hon. Commissioner of Patents & Trademarks
Washington, D. C. 20231

Sir:

This is in response to the new arguments raised in the Examiner's Answer mailed August 3, 1999.

In response to appellant's argument concerning the rejection of the claims under 35 USC §103 as obvious over Ruddell in view of Brown, the Examiner states, *inter alia*, that:

"The combination of Ruddell in view of Brown shows all the structure recited. ... Apparatus claims must be distinguished from the prior art in terms of structure rather than function. See In re

Danly, ... 120 USPQ 528, 531 (CCPA 1959). See MPEP 2114."

This is an apparent reference to appellant's argument that in order to read the structure of the primary reference Ruddell on the claimed insect trap, one must invert the drawing Figs. of Ruddell, i.e., turn the device "upside down." In the Brief on Appeal, appellant argued that it is impermissible to invert an apparatus in clear violation of the function for which the reference device was intended in order to meet the limitations of a claim. In support of his argument, appellant drew attention to the decision in *In re Gordon*, 221 USPQ 1125 (CAFC 1984), which is discussed at pages 10-12 of the Brief on Appeal.

The decision in *In re Danly* is not apposite vis-a-vis whether it is appropriate to invert a device disclosed by the prior art, thereby destroying its function in order to meet the limitations of a claim. Appellant has no quarrel with the holding in *Danly*, namely, that "claims drawn to an apparatus must distinguish from the prior art in terms of structure rather than function" (120 USPQ 528, 531). Indeed, appellant has shown that the claims distinguish from the prior art in terms of structure rather than function since the appropriate structure for Ruddell is that depicted in the figures of the drawing and not the inverted form to which the Examiner alludes. The

decision in *Gordon* stands for the proposition that a depicted device in a disclosure cannot be inverted so as to vitiate its function merely in order to meet the limitations of a claim. The decision in *Danly* does not controvert that holding. Accordingly, it is respectfully submitted that the Examiner has not countered this argument, nor successfully refuted that the decision in *Gordon* is controlling with respect to the facts herein.

In that portion of the Examiner's Answer bridging pages 3 and 4, the Examiner states, *inter alia*, that:

"similarities in structure and function are factors to consider"

in determining the applicability of prior art to patent claims under consideration. Appellant is in agreement with this proposition, but disagrees strongly with the manner in which the Examiner has compared the claimed structure with those of the references. In the discussion bridging pages 3 and 4, the Examiner points out similarities between various elements of the claimed structure and those of Ruddell and Brown. Note, however, that with respect to Ruddell, the Examiner equates various elements of the Ruddell structure with those of the claimed structure regarding function, i.e., "baffle", "entrance", "collection chamber", and the like. These elements function for these purposes, however, only when the device is as depicted in the figures

of the drawing. When the device is inverted in order to meet the limitations of the claim, however, these elements cannot possibly function for their stated purpose. Thus, there are no "similarities in structure and function" between the device as depicted by Ruddell and that of the claims on appeal. Since these are the only factors stated by the Examiner in the Answer to be considered, it is apparent that the Examiner has not made out a *prima facie* case of obviousness.

With regard to appellant's argument that the Examiner's rejection was improperly based on hindsight reasoning, the Examiner states at page 4 that the decision in *In re McLaughlin*, 170 USPQ 209, 212 (CCPA 1971), stands for the proposition that "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time of the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." Again, appellant has no quarrel with this broad proposition. Note, however, that the hindsight reconstruction of the invention requires the Examiner to completely invert the structure disclosed by Ruddell which can only be "gleaned" from appellant's disclosure, thereby rendering this exercise inappropriate. Where is the knowledge within the

level of ordinary skill in the art which would motivate a skilled artisan to turn a prior art device on its head, thereby preventing it from functioning as intended in order to arrive at a claimed invention? It is difficult to imagine a clearer case of inappropriate hindsight reconstruction of an invention than that herein.

As stated in *Uniroyal v. Rudkin-Wiley*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 US 825 (1988):

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

It is apparent that in the present appeal, this is precisely what the Examiner has done in arriving at the subject matter of the appealed claims. It would appear to be impossible to agree with the Examiner that one of ordinary skill in the art would have arrived at the subject matter of the appealed claims based on the teachings of Ruddell and Brown alone.

Courts of review have repeatedly cautioned against employing hindsight by using an applicant's disclosure as a blueprint to reconstruct a claimed invention out of isolated teachings of the prior art. See *Grain Processing Corp. v. American-Maize Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That Court has also cautioned against

focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as 35 USC §103 requires. See *Hybritech v. Monoclonal Antibodies*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (CCPA 1986), *cert. denied*, 480 USPQ 947 (1987). In the present appeal, it is obvious that the Examiner has lost sight of the claimed invention as a whole and has improperly focussed upon the supposed obviousness of the differences between the claimed invention and the prior art cited against the claims. While admittedly, elements of Ruddell and Brown may be combined to arrive at a reasonable facsimile of the claimed invention, such an exercise requires one skilled in the art to turn the device of Ruddell on its head which would be completely nonsensical since it then could not function in the manner for which it was intended.

It is not apparent what test for obviousness the Examiner has applied. It is clear, however, that the Examiner has not followed the guidelines set forth in *Graham v. John Deere*, 383 US 1, 148 USPQ 459 (1966). Instead, the Examiner has acknowledged differences between the claimed invention and the applied prior art and then observed the absence of objective evidence demonstrating unexpected results as though such an observation carried with it a conclusion that the claimed invention was *prima*

facie obvious. This approach improperly places the cart before the horse in that an applicant is not obliged to proffer any objective evidence of non-obviousness until such time as the Examiner has established a *prima facie* case of obviousness. *Ryco v. Ag-Bag*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988); *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988); *Custom Accessories v. Jeffrey-Allan Industries*, 807 F.2d 955, 1 USPQ2d 1196 (Fed. Cir. 1986); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present situation, the Examiner has failed to establish any basis in fact and/or cogent scientific rationale to reasonably support the conclusion that one having ordinary skill in the art would have been motivated to completely invert the device disclosed by Ruddell to arrive at the invention set forth in the instant claims.

For the reasons set forth in the Brief on Appeal and those set forth hereinabove, it is respectfully submitted that the Examiner has not made out a *prima facie* case of obviousness and that the final rejection of record should be reversed and the case remanded to the Examiner for immediate allowance.

Serial No. 08/654,600

Docket No. 5383

To the extent necessary, appellant petitions for an extension of time under 37 CFR §1.136. Please charge any fees due to Deposit Account No. 11-0610 (Docket No. 5383).

Respectfully submitted,

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